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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,334	06/20/2003	Steven S. Diamond	05127-000229	6990
22910	7590	07/24/2006	EXAMINER	
BANNER & WITCOFF, LTD. 28 STATE STREET 28th FLOOR BOSTON, MA 02109-9601			HANEY, RICHAE LEE	
			ART UNIT	PAPER NUMBER
			3765	

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/601,334

**Applicant(s)**

DIAMOND ET AL.

**Examiner**

Richale L. Haney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-44 is/are allowed.
- 6) ☒ Claim(s) 1-16, 45, 47, 48, and 49 is/are rejected.
- 7) ☒ Claim(s) 46 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

The amendment of 12/22/2005 is non-compliant see claims 27 –35. The Request for Continued examination filed on 4/13/2006 has been received. Claims 1 – 49 are pending in the application.

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 – 5, 8, 9, 13, 14, 16, 45, 47, and 48 are rejected under 35 U.S.C. 102(b) as being anticipated by Whang (US 6,199,213). The device of Whang discloses an article of headwear having an adjustable configuration comprising a crown portion (31), a bill (21), and a sweatband (26) secured to a peripheral edge of the crown (31) comprising an inner piece that is in an unfolded condition having opposed longitudinal edges and folded about itself such that the opposed longitudinal edges of the inner piece are proximate one another to form a seam (Figure 1B, 15) and a filler piece of elastic material (Figure 1B, 14) is secured to the crown and the sweatband by stitching that extends substantially parallel to and proximate each of the opposed longitudinal edges of the filler and the inner piece (Figures 1A and 1B). The stitching that extends parallel and proximate the longitudinal fold also secures the sweatband to the crown (Figure 3, 30). The inner piece is formed of a cotton spandex blend ranging from 0 – 4%

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spandex and 96 – 100% cotton (Column 5, lines 35 – 38) and the crown portion is made of a plurality of bias cut stretchable gores (Column 2, lines 19 – 22). The filler piece formed of polyester would inherently have some degree of elasticity in order for the device to operate.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 6 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whang in view of Shin (US 6,477,715). The device of Whang shows all of the claimed invention except for the binding being secured to the inner piece with adhesive. The device of Shin discloses a binding tape secured to an inner headband with adhesive (Figure 6, 10 and Column 3, lines 10 -12). Applicant's specification does not provide unforeseen results achieved for using one particular fastening means over another. It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the device of Whang, by incorporating adhesive as a means for securing, as taught by Shin in order to achieve an inexpensive method of manufacture.

3. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Whang in view of Piche (US 5,317,761). The device of Whang shows all of the claimed invention

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except for the inner sweatband attached to a crown by means of adhesive. The device of Piche teaches a sweatband secured to the inner portion of a crown by means of adhesive (Column 3, lines 22 - 29). It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the device of Whang by attaching the inner sweatband by adhesive as taught by Piche in order to provide a removable attachment to prevent the headwear from becoming soiled (Column 1, lines 67 - 68).

4. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Whang in view of Nebeker (US 5,566,395). The modified device of Whang shows all of the claimed invention except for the filler piece being formed from elastane. The device of Nebeker discloses a sweatband with a sponge core filler made from rubber or latex (Column 3, lines 60 -63). It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the device of Whang by using an elastane core filler as taught by Nebeker in order to create a adjustable, stretchable headband.

5. Claims 11, 12, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whang in view Park (US 6,016,572). The device of Whang substantially discloses the claimed invention but is lacking an inner piece that is cut on the bias. The device of Park discloses an inner elastic headband that is cut on the bias (Column 3, lines 33 - 34) to obtain stretch. It would have been obvious to one of ordinary skill in the art at the time the invention was made to cut the sweatband and the

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binding fabric of Whang on the bias in order to obtain stretch since this is a well-known method of achieving stretch in the art.

***Allowable Subject Matter***

6. Claims 17 – 44 are allowed.
7. Claim 46 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

8. Applicant's arguments with respect to claims 1 – 49 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richale L. Haney whose telephone number is 571-272-8689. The examiner can normally be reached on M-F 8:00 - 4:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Welch can be reached on 571-272-4996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Richale L. Haney  
Patent Examiner  
Art Unit 3765  
June 27, 2006

RLH

  
**KATHERINE MORAN**  
**PRIMARY EXAMINER**